

PATENT  
Attorney Docket No. 5822.03

### REMARKS

In the Action, the Examiner identified that the oath or declaration is defective because it fails to claim the priority dates for the benefit of the parent applications (identified above in the amended Cross Reference to Related Applications section). Applicant will provide a new declaration executed by the inventors.

#### Rejections under 35 U.S.C. §102(e)

The Examiner rejected claims 1 and 3-11 under §102(e) as being anticipated by U.S. Patent No. 5,590,197 issued to *Chen et al.* on December 31, 1996 (hereinafter, "Chen"). Applicant appreciates the Examiner's careful review of the application and the cited references. Applicant respectfully traverses these rejections and submits that all claims are patentable over Chen for the reasons set forth below.

#### Independent Claim 1

The Examiner alleged that Chen teaches all of the steps of independent claim 1. Applicant respectfully disagrees for the reasons set forth below. In finding each of the claim elements anticipated, the Examiner cited all of the Summary of the Invention, Brief Description of the Drawings and Detailed Description of the Preferred Embodiments (i.e., col. 3, line 33 to column 7, line 9) as anticipating the claim elements. Applicant respectfully contends that none of the disclosure in Chen identifies any of the claim elements set forth in claim 1.

More specifically, Applicant asserts that Chen fails to disclose the steps of "first storing registration information related to the user in a first data store on a first node of a network". Applicant contends that there is no section in Chen which specifically provides for storing user registration information at any node of a network or any other type of user information at any node of a network. In fact, the only mention of user related information in Chen is during the discussion of the processing of a transaction request by an account servicer. More specifically, Chen provides that the account servicer approves transactions based upon the "status of the customer's account and the amount of the transaction." (col. 4, lines 19-20) Chen does not state that the account servicer "stores" such information, nor does it state from where such information is obtained. Clearly, the status of a customer's account and the amount of a

PATENT  
Attorney Docket No. 5822.03

transaction are not "registration information related to [a] user" as provided for in the present application.

Similarly, Chen does not provide for the "second storing said registration information in a second store on a second node of said network, said second node being different from said first node", as required by independent claim 1 of the present application. Since Applicant contends that registration information is never "first stored" in Chen, then clearly it can not be "second stored". Thus, Applicant respectfully submits that nowhere in the entirety of Chen is the concept of storing user demographic information ever discussed, mentioned or suggested. Additionally, Chen is specifically directed to a system and method for preventing the dissemination user registration information. Thus, Chen clearly teaches away from "second storing" user registration information at a second node, which would necessarily require the dissemination of the user registration information.

Further, Chen clearly does not "provid[e] the user with a user identification code permitting access to said registration information in at least one of said first and second stores". The codes (i.e., the public keys) provided in Chen are utilized for the specific purpose of providing "what ever information is needed by the account servicer to authorize a transaction and, uniquely, a file containing a plurality of public keys.... these keys are used to protect the information on the card as it is being transmitted." (col. 5, lines 40-48). Thus, the codes/public keys discussed in Chen are not provided in order to "permit access to registration information." Rather, they are provided in order to protect the limited amount of information necessary for an account servicer to approve a transaction. More specifically, the codes/private keys in Chen are used to prohibit access to information and are not provided to permit access to stored user registration information.

Chen is specifically directed to protecting the security of user account information. As such, Chen teaches away from the present invention in that the information provided to the merchant/third party web site is not user registration information. In contrast, the systems and methods of the present application are designed to expedite the controlled transmission of user registration information to such third party web sites. Thus, Chen is directed to securing information, while the present application is directed to systems and methods for disseminating user registration information automatically or upon receiving user approval.

PATENT  
Attorney Docket No. 5822.03

Further, Chen does not provide for "supplying to at least one requested node of said plurality of requested nodes: (a) said user identification code for registering the user at said at least one requested node, and (b) said registration information transmitted from one of said first and second stores for registering the user at said at least one requested node." In fact, Chen attempts to prevent the communication of user registration information to third parties. Further, the Examiner cited Fig. 1 of Chen in finding this element of claim 1 anticipated by Chen. Applicant respectfully contends that Fig. 1 does not in any manner support an interpretation that user registration information is being supplied to a merchant processor (or a "requested node"). Chen describes Fig. 1 as providing "a medium for the transfer of credit card account information." (col. 4, lines 45-46) Further, Chen states, with reference to Fig. 1, that "the merchant will still have no access to any information in the authorization ticket which it forwards from the customer to the account servicer." (col. 7, lines 6-8) Thus, it is clear that, in Chen, third party web sites/merchant processors/"requested nodes" are not provided with "user registration information". In fact, Chen is specifically configured to prevent the dissemination of such user registration information to third parties.

In essence, Chen attempts to limit the dissemination of user demographic information to third parties. In contrast, the present application provides a system and method for efficiently disseminating user demographic information in a controlled manner. Thus, Chen and the present application are entirely unrelated in the problems they attempt to solve and the systems and methods used to solve such problems.

For all the foregoing reasons, Applicant respectfully submits that Chen does not anticipate independent claim 1. Accordingly, Applicant respectfully requests that the Examiner withdraw her rejection and allow claim 1 as patentable over the cited reference.

#### Dependent Claims 2-9

Applicant respectfully submits that he has shown that claims 2-9 all depend from a patentably distinct independent claim. Accordingly, claims 2-9 are themselves patentable. Therefore, Applicant respectfully requests that the Examiner withdraw her rejections and allow these claims. Applicant makes this request without reference to any other bases of patentability contained within the dependent claims, and such request should not be read as an admission that patentable subject matter is lacking in any dependent claim.

PATENT  
Attorney Docket No. 5822.03

Independent Claims 10 and 11

Applicant respectfully contends, based upon the arguments set forth above with respect to independent claim 1, that claims 10 and 11 are also patentably distinct over Chen and all of the prior art of record. Applicant's attorney respectfully requests the Examiner to contact him via telephone should the Examiner fail to appreciate the applicability of the preceding arguments with respect to independent claims 10 and 11. In essence, Chen teaches a system for preventing and protecting the distribution of account information whereas the present application provides systems and methods for distributing user registration information.

Rejections under 35 U.S.C. §103

The Examiner also raised concerns with the ownership of the inventions covered by the various claims in the present application. Applicant states that, since inception, the inventors of the concepts disclosed in the present application have been under an obligation to assign such inventions to Customer Communications Group and that such Assignment was recorded on February 7, 1996 with the United States Patent and Trademark Office.

Further, the Examiner also rejected claim 2 under §103(a) as obvious in view of Chen, further in view of U.S. Patent No. 5,813,009 issued to Johnson et al. on July 28, 1995 (hereinafter, "Johnson"). Applicant appreciates the Examiner's review of the cited references.

The Examiner states that Chen teaches all of the elements of claim 2 except for the order in which the information is stored. The Examiner relies upon Johnson to teach the storing of the registration information on the client side first and then on the server side. Applicant respectfully traverses this rejection and relies upon the arguments discussing Chen submitted above with respect to independent claim 1.

Further, assuming for point of discussion only that Chen covered all of the elements of claim 1, interpreting Chen in light of Johnson appears to be logically inconsistent. Chen provides that an electronic wallet is provided to a user for effecting electronic transactions. Clearly, the user information can not first be stored by the user on the electronic wallet because the user does not possess the electronic wallet until it is provided by the issuer (i.e., the credit company). The issuer can not generate an electronic wallet until they have sufficient information to associate the electronic wallet with an user account (such information generally requires an

PATENT  
Attorney Docket No. 5822.03

account number, an account name and an expiration date for the account). Thus, it is illogical (and therefore arguably non-obvious) to combine Chen and Johnson because Chen teaches a contrary position to that taught in Johnson. In Chen, account information along with a public key has to first be provided to the issuer and encoded into the electronic wallet before the electronic wallet can be issued. Providing an electronic wallet and then storing user account information with an issuer (as allegedly taught by Johnson or as is suggested by the Examiner as being obvious to one of ordinary skill in the art) would result in the very occurrence which Chen is trying to avoid – namely, the communication of user information with an electronic wallet identification.

Further, the Examiner cited col. 23, lines 55-65 as supporting the proposition that Johnson teaches the storage of user information on the client side first and then on the server side. This cited passage essentially provides that upon insertion of a smart card, a user can download information from an archival facility provided the smart card has the proper authorizations. The Johnson specification further provides that if the request is valid, the archival authority (not the user or the user's card) then provides the requested records/information to the requestor. Thus, Johnson does not support the Examiner's argument that information (let alone "user registration information") is first stored on the client side and then provided to the server side. In Johnson, the archival facility provides archived records of "paper records, or microfilm or fiche" (col. 24, lines 28-29) which arguably do not exist on the user's node. In short, Chen does not disclose the elements of claim 2, as discussed previously, and Johnson does not provide for storing information first on a client node and then on a server node. As such, to the extent that the Examiner is relying on common knowledge in the art or is attempting to take official notice of facts outside the record, please consider this a request under MPEP § 2144.03 that the Examiner provide a reference supporting this position. Applicant respectfully contends that there is no teaching in Chen or Johnson to combine such references and thus a prima facie case of obviousness does not exist.

Therefore, Applicant respectfully requests that the Examiner withdraw her rejection of claim 2 and allow this claim as patentable over the cited references.

Double Patenting Rejection under 35 U.S.C. 101

PATENT  
Attorney Docket No. 5822.03

The Examiner also rejected claims 1-11 under 35 U.S.C. 101 as claiming the same invention as that of claim 1-11 of prior U.S. Patent No. 5,790,785 (hereinafter, the "'785 patent"). Applicant respectfully traverses this rejection. Applicant notes that under *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), as stated in the MPEP §804(II)(A)(second paragraph) that "a reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent." Applicant contends that claims 1-11 in the present application are broader than the claims in the '785 patent.

More specifically, Applicant directs the Examiner's attention to the language "said registration information including demographic information regarding the user that is useful by web site operator in monitoring web site usage". This language is present in each of independent claims 1, 10, and 11 of the '785 patent, but is not present in claims 1, 10 and 11 of the present application. Basically, the independent claims in the present application may, but do not have to include demographic information that is "useful by web site operators". As such, claims 1, 10 and 11 of the present application are arguably broader than the corresponding claims in the '785 patent. It is conceivable that a user may provide demographic information that is not "useful by web site operators in monitoring web site usage." Examples of such information might include a user's telephone number. Arguably, a user's telephone number probably is not "useful by web site operators in monitoring web site usage" but such information is useful for other purposes (for example, telemarketing – which is totally unrelated to "monitoring web site usage").

In short, independent claims 1, 10 and 11 of the present application are arguably broader than the corresponding claims in the '785 patent. Since such claims are broader, they may be literally infringed even though the claims in the '785 patent are not literally infringed. Therefore, in light of *In re Vogel*, Applicant respectfully contends that all of the claims are patentably distinct from the claims set forth in the '785 patent. Applicant respectfully requests the Examiner rescind the double patenting rejection and allow all of the claims in the present application.

## CONCLUSION

The Applicant thanks Examiner Wang for her careful review of the pending application. Applicant respectfully states that he has fully and completely responded to all bases of rejection

PATENT  
Attorney Docket No. 5822.03

alleged by the Examiner in the Action. Applicant submits that the present application overcomes all objections and is in a form fit for allowance. Therefore, in view of the above, Applicant respectfully requests allowance all pending claims. Should there be any remaining informalities or questions which may be resolved via telephone, the Examiner is invited to contact Applicant's attorney, John T. Kennedy, at (303) 260-6362.

Attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached page is captioned **VERSION WITH MARKINGS TO SHOW CHANGES MADE**.

Dated: 4/26/02

Respectfully submitted,

John T. Kennedy  
By: John T. Kennedy  
USPTO Reg. No. 42,717  
DORSEY & WHITNEY LLP  
Customer No. 20686

PATENT  
Attorney Docket No. 5822.03

**VERSION WITH MARKINGS TO SHOW CHANGES**

**In the Specification:**

Please amend the "Related Application" section of the specification, provided on page 1 of the present application, to read as follows:

**Cross Reference to Related Applications**

The present application is a continuation of United States Patent Application Serial Number 09/128,915 filed on August 4, 1998 which is a continuation of United States Patent Application Serial Number 08/595,837, filed on February 2, 1996 which claims priority to United States Provisional Application Serial Number 60/008,736 which was filed on December 11, 1995 all of which are entitled "World Wide Web Registration Information Processing System" and the contents of each of which are incorporated herein by reference in their entirety.

**END OF DOCUMENT**